

REMARKS/ARGUMENTS

Claims 1-7 and 9-11 are pending.

The Information Disclosure Statement (IDS) dated June 3, 2002 had attached to it a copy of the German Search Report dated February 19, 2002, and an English translation thereof, as is evidenced by the attached copy of a return postcard, date-stamped by the Patent Office, and listing as attachments “IDS; 12 references, German Search Reports w/English translations”. For the Examiner’s convenience, also attached hereto are copies of the German Search Report and the English translation thereof, as originally filed.

The same comments apply to the second IDS dated August 9, 2002, and the undersigned confirms that a copy of the German Search Report dated February 19, 2002, together with an English translation thereof, accompanied this IDS. Attached is a copy of a return postcard date-stamped by the Patent Office, although this postcard does not separately list the German Search Report and the English translation thereof. For the Examiner’s convenience, copies of the German Search Report and its English translation accompanying the second IDS are attached hereto.

In view thereof, applicant requests that all references (including those not in the English language) submitted with the two IDSs be considered and made of record herein.

The specification has been conformed to the preferred format as required in the above-referenced Office Action, and a Substitute Specification together with a Comparison Copy are attached hereto.

Amended claim 1 is a combination of original claims 1 and 8. Amended claim 1 and all dependent claims include a number of changes, most of them required as a result of the deletion of the phrase “characterized in that”, which were made for purposes of clarification unrelated to patentability concern. Further, all reference numerals were deleted from the claims.

Claim 1, which has the same content as original, now-canceled claim 8, was rejected for obviousness over Endo (4,634,272) in view of Araki (4,656,462) and Pierenkemper (6,509,958). The Pierenkemper patent was relied upon for its teachings to provide “a light deflection device”.

Pursuant to 35 U.S.C. §103(c), Pierenkemper cannot be used to render the pending claims obvious, since Pierenkemper and the present application were owned by the same assignee at the time of filing, namely SICK AG. The American Inventors Protection Act of 1999 (“AIPA”) amended 35 U.S.C. §103(c) to add that subject matter that only qualifies as prior art under 35 U.S.C. §102(e) and that was commonly owned, or subject to an obligation of assignment to the same person at the time the invention was made, cannot be applied in a rejection under 35 U.S.C. §103(a). Specifically, §103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

According to the AIPA §4807(b), §103(c) applies to any patent application filed on or after the date of enactment, November 29, 1999. See also MPEP §§706.02(k) and 706.02(11)-(13) and the Official Gazette dated December 26, 2000, which explains the USPTO’s current policy towards §103(c).

Here, the present application was filed on March 5, 2002 (i.e., after November 29, 1999) so that the changes to §103(c) made by the AIPA apply to this application. Pierenkemper issued on January 21, 2003, which is after the filing date for the present application (March 5, 2001). Accordingly, if Pierenkemper is prior art at all, it is prior art under 35 U.S.C. §102(e), but not under §103(c).

Pierenkemper and the present application were also commonly owned or subject to assignment to the same person, SICK AG, at the time that the invention of the present application was made. In this regard, the undersigned, an attorney of record, states:

U.S. Patent Application No. 10/092,942 and U.S. Patent No. 6,509,958 were, at the time the invention of U.S. Patent Application No. 10/092,942 was made, owned by SICK AG of Waldkirch, Germany, or subject to an obligation of assignment to SICK AG of Waldkirch, Germany.

In support thereof, applicant attaches copies of the official Notice of Recordation of Assignment Document for the present application and for the Pierenkemper patent.

In sum, because Pierenkemper is only prior art under 35 U.S.C. §102(e) and because Pierenkemper and the present application were commonly assigned to SICK AG, Pierenkemper cannot be used to render the claims obvious pursuant to 35 U.S.C. §103(a).

In view thereof, applicant requests that the rejection of claims 8-11, and therewith of amended claim 1, because it is a combination of original claims 1 and 8, be withdrawn.

Since the remaining dependent claims 2-7 now depend from allowable claim 1 and are directed to specific features of the present invention, applicant submits that all pending claims 1-7 and 9-11 are in condition for allowance.

In the context of the obviousness rejection of claim 8 as set forth on page 8 of the above-referenced Office Action, applicant notes that "Saunders" is mentioned but assumes that this is in error and that it was intended to refer to Pierenkemper because the Saunders patent, made of record herein, has not been applied against any of the claims, including claims 8-11.

In view of the foregoing, applicant submits that this application is in condition for allowance, and a corresponding notification at an early date is requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



J. Georg Seka
Reg. No. 24,491

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor

San Francisco, California 94111-3834

Tel: (415) 576-0200

Fax: (415) 576-0300

JGS: jhw

SP 1460338 v1